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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,702	01/30/2001	Yuji Tsukamoto	088941/0182	9491

22428 7590 09/22/2004

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EXAMINER	
USTARIS, JOSEPH G	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/771,702	TSUKAMOTO, YUJI	
	Examiner	Art Unit	
	Joseph G Ustaris	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 3 and 5.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Cantone (US005734781A).

Regarding claim 1, Cantone discloses a digital videocassette used in a "digital contents rental system" (See Fig. 1 and column 5 lines 43-57). The system utilizes a digital videocassette or "portable recording medium which contents are stored in" (See Fig. 1) and a distribution center or "download apparatus" at the video store (See column 3 lines 9-13; column 5 lines 45-50) that is inherently "managed by a rental agent". The distribution center has a mass computer database of movies or "internal storage unit", where inherently the movies are "stored beforehand" (See column 5 lines 45-50). The distribution center or "download apparatus" downloads "the internal contents to said recording medium in compliance with a command from a user or a staff member" (See column 5 lines 43-57). The digital videocassette also serves the function of an "adaptor", where it "reads the contents stored in said recording medium and outputs them to a display device" (See column 2 lines 58-65), where inherently the "adaptor" is used at the "user's home".

Regarding claim 2, the distribution center at the video store "writes a rental period in said recording medium in compliance with a command from said user or staff member" (See column 5 line 63 – column 6 line 3) and the digital videocassette or also known as an "adaptor" "prohibits output outside said rental period when outputting the contents stored in said recording medium to said display device" (See column 5 lines 63-66).

Regarding claim 4, the distribution center at the video store "calculates a rental fee for the contents in accordance with said rental period" (See column 5 line 66 – column 6 line 3).

Regarding claim 6, the distribution center at the video store also "calculate a rental fee in accordance with the type of contents" (See column 6 lines 4-7).

Regarding claim 12, the "recording medium comprises a magnetic disk apparatus" (See column 2 line 66 – column 3 line 1).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantone (US005734781A) in view of Braitberg et al. (US006631359B1).

Claim 3 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. However, Cantone does not disclose that the distribution center at the video store "writes a number of permissible copies in said recording medium" and for the "adaptor to prohibit copies exceeding the number of permissible copies when copying the contents stored in said recording medium to an outside storage unit".

Braitberg et al. (Braitberg) discloses a system for access control over writeable medium. Braitberg discloses that information content-mastered (ICM) data is written on the writeable medium or "recording medium" that controls access to the content stored on the writeable medium. The ICM data contains keys for specifying conditions and parameters that restrict access, i.e. a maximum number of permissible copies. Inherently, the system prevents additional copies exceeding the maximum number or "prohibit copies exceeding the number of permissible copies when copying the contents" unless proper royalty fees have been paid to gain authorization (See column 1 lines 24-43; column 15 lines 20-23, lines 41-46, lines 54-59). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the distribution center and digital videocassette disclosed by Cantone to "write a number of permissible copies in said recording medium" and for the digital videocassette to "prohibit copies exceeding the number of permissible copies when copying the contents stored in said recording medium to an outside storage unit", as taught by Braitberg, in order to enhance the security features thereby reducing the amount of illegal use of the content, i.e. unauthorized duplication.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantone (US005734781A) in view of Braitberg et al. (US006631359B1) as applied to claim 3 above, and further in view of Suzuki (US006401243B1).

Cantone in view of Braitberg does not disclose calculating a "rental fee for the contents in accordance with said number of permissible copies".

Cantone in view of Braitberg does disclose various methods for collecting usage fees, where the user pays a fee for a license granting access. Suzuki discloses a method for collecting copyright fees for distributed content. Suzuki further discloses that additional copyright fees are applied to the user each time a video program is copied or "calculating a rental fee for the contents in accordance with a number of permissible copies" (See Fig. 12 and column 16 lines 5-18). Therefore, it would have been obvious to one with ordinary skill in the art at time the invention was made to modify the distribution center disclosed by Cantone in view of Braitberg to calculate a "rental fee for the contents in accordance with said number of permissible copies", as taught by Suzuki, in order to provide another means of generating revenue from the copyrighted content.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cantone (US005734781A) in view of Abecassis (US006553178B2).

Claim 7 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. However, Cantone does not disclose

"advertisement images that are stored beforehand in the internal storage unit of the download apparatus, and the download apparatus writes the advertisement images together with the contents to recording medium".

Abecassis discloses an advertisement subsidized video-on-demand system. The system transmits advertisements or "advertisements images" from the providers/distributors to various users, where inherently the provider/distributor has the advertisements "stored beforehand" or "advertisement images that are stored beforehand in the internal storage unit of the download apparatus". The advertisements are downloaded to a RAViT device where the user can view them or "download apparatus writes the advertisement images to the recording medium" (See column 48 lines 1-15). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the distribution center disclosed by Cantone to be able to store and provide "advertisement images", where the distribution center would "write the advertisement images to the recording medium", as taught by Abecassis, in order to expand the capabilities of the system thereby providing another source of revenue.

Regarding claim 8, Cantone in view of Abecassis disclose a system where the user/viewer is compensated for viewing the advertisements, i.e. the user is credited 30 minutes of free viewing or "calculates the rental fee for the contents in accordance with the number of advertisement images" (See Abecassis column 1 lines 25-30; column 4 lines 44-50; column 47 lines 46-56).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantone (US005734781A) in view of Yamanaka (EP0975111A2).

Claim 9 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. However, Cantone does not disclose that the distribution center "calculates the total number of rentals of each content, and the rental agent who manages said download apparatus pays a fee for using the contents to a contents supplier in compliance with said total number of rentals".

Yamanaka discloses a copyright management apparatus used within a distribution system. The management system is able to track the number of times a subscriber accesses the contents or "calculates the total number of rentals of each content" and is able to pay the copyright holder the appropriate amount based on the use of the content or "pays a fee for using the contents to a contents supplier in compliance with said total number of rentals" (See Fig. 1, 2, 11, and 12; paragraph 0041-0042). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the distribution center disclosed by Cantone to "calculate the total number of rentals of each content, and the rental agent who manages said download apparatus pays a fee for using the contents to a contents supplier in compliance with said total number of rentals", as taught by Yamanaka, in order to ensure that the copyright holder receives revenue that is proportional to the usage of the content.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantone (US005734781A) in view of Braitberg et al. (US006631359B1) as applied to claim 3 above, and further in view of Yamanaka (EP0975111A2).

Cantone in view of Braitberg does not disclose that the distribution center "calculates the total number of permissible copies of each content, and the rental agent who manages said download apparatus pays a fee for using the contents to a contents supplier in compliance with said total number of permissible copies".

Cantone in view of Braitberg does disclose various methods for collecting usage fees, where the user pays a fee for a license granting access (See Braitberg column 1 lines 24-43). Yamanaka discloses a copyright management apparatus used within a distribution system. The management system is able to track the number of times a subscriber downloads the contents or "calculates the total number of permissible copies of each content" and is able to pay the copyright holder the appropriate amount based on the use of the content or "pays a fee for using the contents to a contents supplier in compliance with said total number of permissible copies" (See Fig. 1, 2, 11, and 12; paragraph 0041-0042). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the distribution center disclosed by Cantone in view of Braitberg to "calculate the total number of permissible copies of each content, and the rental agent who manages said download apparatus pays a fee for using the contents to a contents supplier in compliance with said total number of permissible copies", as taught by Yamanaka, in order to ensure that the copyright holder receives revenue that is proportional to the usage of the content.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cantone (US005734781A) in view of Abecassis (US006553178B2) as applied to claims 7 and 8 above, and further in view of Angles et al. (US006385592B1).

Cantone in view of Abecassis does not disclose that the distribution center "calculates the total number of times each of said advertisement images was written, and the rental agent who manages said download apparatus sends an advertisement fee invoice to an advertisement image supplier in compliance with said total number of times said advertisement images was written".

Angles et al. (Angles) discloses a system that monitors the deployment of advertisements or "advertisement images" within an interactive communications system that can deliver video data. The system monitors the number of times an advertisement has been viewed by consumers or "calculates the total number of times each of the advertisement images was written" and the advertisement providers or "advertisement image supplier" can pay the content provider based on the number of advertisements viewed, where inherently that system sends "an advertisement fee invoice to an advertisement image supplier in compliance with said total number of times said advertisement images was written" (See column 16 lines 28-50). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the distribution center disclosed by Cantone in view of Abecassis to "calculate the total number of times each of said advertisement images was written, and the rental agent who manages said download apparatus sends an advertisement fee

invoice to an advertisement image supplier in compliance with said total number of times said advertisement images was written", as taught by Angles, in order to provide a automated billing system thereby not requiring the video store to maintain an advertising administrative/accounting staff.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please take note of Palatov et al. (US20010029583A1) for their similar method of video distribution using an interactive kiosk.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G Ustaris whose telephone number is 703-305-0377. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGU
September 15, 2004

VIVEK SRIVASTAVA
PRIMARY EXAMINER